REMARKS/ARGUMENTS

The final office action of February 8, 2005 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 35-53 remain in this application. Claims 1-34 were previously canceled.

Applicants wish to thank Examiner Huynh for the courtesies extended to the undersigned during the telephonic interview on February 14, 2005.

Claims 35-53 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 5,911,776 to Guck in view of U.S. patent no. 5,557,722 to DeRose et al. ("DeRose"). Applicants respectfully traverse this rejection.

As explained during the telephonic interview, Guck does not teach or suggest interrogating an output device to determine its capabilities and selecting a format based upon the set of capabilities of the output device determined by interrogating the output device as recited in independent claim 35; DeRose does not cure this deficiency of Guck. The final office action refutes applicant's position as follows:

> In Guck, the shadow file is created for including the format of the source document corresponding [to] each type of receiver's appliances, which are equivalent to the output devices (abstract, col. 4, lines 41-54, col. 16, lines 45-60). As admitted by Applicants, the required conversion parameters *have already [been] established when the output device is ultimately identified* for providing a suitable format to a user's request. This implies that the output devices as well as their capabilities are identified in advance by checking each type of the output devices for determining their capabilities. In other words, said identifying the output devices further implies interrogating the output devices for their capabilities for creating the shadow files, which include the formats, for the source document.

(Emphasis original).

Applicants respectfully disagree with the action's allegation that "the output devices as well as their capabilities are identified in advance *by checking each type of the output devices for determining their capabilities*. In other words, said identifying the output devices further implies interrogating the output devices for their capabilities *for creating the shadow files*." (Emphasis added). To the contrary and as emphasized during the telephonic interview, at the time of

creating the shadow file, <u>no output device has been interrogated</u>. According to <u>Guck</u> a user decides which formats he would like his original (source) document to be available in and creates a shadow file for each desired format, where each shadow file points to a corresponding object, i.e., a dedicated converter. See Fig. 2B. More particularly, <u>Guck</u> at col. 7, lines 39-42, expresses

> the user now has the option to use the present system to describe all of its possible <u>future</u> needs and thus he can utilize the database 58 in Server 50 in order to create many different types of shadow files which relate to each of the possible different formats that might be required.

(Emphasis added). Nowhere does Guck expressly or impliedly suggest that any output device is interrogated for their capabilities to create a corresponding shadow file. Tellingly, the shadow files described in <u>Guck</u> are associated with known document formats and protocols, such as GIF, TIFF, RTF, HTML etc., which parameters are known and do not require the interrogation of a particular output device to determine the parameters. The required conversion parameters have already been established when the output device is ultimately identified and the desired format requested. In contrast, according to the claim 35 invention, the capabilities of the output device can include device specific characteristics, such as resolution, aspect ratio, display size, color depth, color palette and supported font. Notably, all these capabilities can change from device to device even when the same output format (e.g., HTML) is required). For example, a user who is sight impaired may device a large font size for their output device than a user who is not sight impaired. Applicants have further amended claim 35 to clarify that interrogating occurs *in response to a request for the document*. In sum, <u>Guck</u> lacks an express or implied teaching or suggestion of interrogating an output device to determine a set of capabilities of the output device in response to a request for the document or selecting a format based upon the set of capabilities of the output device determined by interrogating the output device.

<u>DeRose</u> does not overcome the aforementioned deficiencies of <u>Guck</u>. Thus, the combination of <u>Guck</u> and <u>DeRose</u>, even if proper, does not result in the claim 35 invention. Independent claim 42 as amended calls for, among other features, interrogating the output device to determine a set of capabilities of the output device in response to a request for the document; and generating a selected style sheet based upon the set of capabilities of the output device

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determined by interrogating the output device using the layout generator. Independent claim 48 as amended calls for, among other features, interrogating the output device to determine a set of capabilities of the output device in response to a request for the document; and based upon the set of capabilities of the output device determined by interrogating the output device, generating a style sheet. Thus, for substantially the same reasons as set forth with respect to claim 35, the combination of Guck and DeRose, even if proper, does not result in the invention of claims 42 and 48.

Claims 36-41, 43-47 and 49-53, which ultimately depend from claims 35, 42 and 48, respectively are patentably distinct from the combination of Guck and DeRose for the same reasons as their ultimate base claim and further in view of the additional advantageous features recited therein.

The current action failed to address the applicants' arguments in the last response, that no teaching or suggestion of a layout generator had been identified as recited in claim 36. The action continues to admit that neither Guck nor DeRose explicitly discloses a layout generator, yet fails to clearly articulate how the combination provides such a feature. Applicants note that a number of other claims call for a layout generator including independent claims 42 and 48. Applicants submit that the finality of the instant action be withdrawn due to these points not being addressed in the last response.

CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.
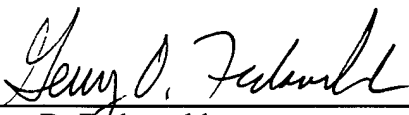
All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: April 1, 2005   By: _____

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